

## REMARKS

A first non-final Office Action mailed September 16, 2003 has been received and carefully reviewed. Claims 1-15 are pending in the application. Claims 16-23 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Claims 1-15 have been rejected. New claims 24-31 have been added. Reconsideration of the application as amended is respectfully requested in view of the following remarks.

Applicant acknowledges the objections to the drawings. Applicant submits herewith a replacement drawing of Figure 5 which now incorporates a pre-stress line 15 as required by the Examiner. An annotated sheet showing the changes to Figure 5 is also attached herewith. No new matter has been added to the specification or drawings.

Claims 1, 5, and 15 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Bowe* (US Patent 6,592,581). *Bowe* discloses an ablation catheter apparatus configured to deliver energy to biological tissue. *Bowe* discloses an apparatus that includes an outer sleeve 100 that surrounds a sheath 118. As is best shown in Figures 5A and 5B, sheath 118 has a closed distal tip, as indicated by the presence of tip electrode 116 disposed at the distal tip of sheath 118.

To anticipate a claim, the asserted reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. All claim elements and their limitations must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102.

*Bowe* fails to disclose an inner sheath comprising an open lumen as is recited in Applicant's claim 1. Inclusion of an open lumen in the presently claimed invention provides the opportunity to deliver payloads of varying types through the open lumen of the inner sheath. The apparatus disclosed in *Bowe* is directed to a different type of

catheter (i.e., ablation catheter) which does not include or need an inner sheath having an open lumen. *Bowe* provides no teaching or suggestion that the sheath 118 could be implemented to include an open lumen. Rather, it would appear that inclusion of an open lumen in sheath 118 would frustrate the objective of the *Bowe* apparatus to include a tip electrode 116 that facilitates delivery of energy to biological tissue during an ablation procedure.

Because *Bowe* fails to teach each and every element of Applicant's claim 1, and because *Bowe* fails to disclose the "identical invention . . . shown in as complete detail" as is recited in Applicant's claim 1, *Bowe* fails to anticipate claim 1.

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bowe* as applied to claim 1 above, and in further view of *Stevens-Wright et al.* (U.S. Patent 5,462,527). Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bowe* as applied to claim 1 above, and further in view of *Zhang et al.* (U.S. Patent 6,574,512). Claims 6 and 11-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bowe* as applied to claim 1 above. Claims 7-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bowe* as applied to claim 1 above, and further in view of *Lepulu et al.* (U.S. Patent 6,533,770).

Concerning the Examiner's obviousness rejections based on the above-listed reference combinations with *Bowe* as the primary reference, Applicant respectfully brings to the Examiner's attention that the instant application and both *Bowe* and *Zhang* are assigned to common assignee, Cardiac Pacemakers, Inc. Applicant makes reference to the assignee information provided on the first page of *Bowe* and *Zhang* and the assignee of record information for the instant application recorded at reel 012817, frame 0088 to evidence such common ownership.

The instant application, *Bowe*, and *Zhang* were, at the time the inventions of *Bowe* and *Zhang* were made, owned by common assignee Cardiac Pacemakers, Inc. Accordingly, *Bowe* and *Zhang* are not qualified references under 35 U.S.C. § 102(e) for purposes of evaluating obviousness, and, therefore, are not available under 35 U.S.C. §

103. As such, *Bowe* and *Zhang* cannot properly be used as references to support the Examiner's instant rejection of claims 2-4 and 6-14 under 35 U.S.C. § 103.

In view of the removal of *Bowe* and *Zhang* as qualified references and the above-made remarks, claims 2-4 and 6-14 are clearly not rendered obvious by the remaining references *Stevens-Wright* and *Lepulu*.

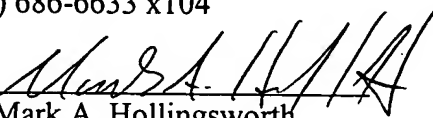
Without acquiescing to the Examiner's characterization of the relied-on references as they have been applied to Applicant's claims, Applicant believes it unnecessary to address all grounds for rejection of every dependent claim in view of the clear grounds for patentability of claim 1. These dependent claims include all of the limitations of claim 1 and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending there from is nonobvious." M.P.E.P. §2143.03; citing *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicant, however, reserves the right to address these rejections should the Examiner maintain the rejection of the claim 1, notwithstanding Applicant's remarks presented hereinabove.

It is believed that claims 1-15 are in condition for allowance and notification to that effect is respectfully requested. It is further believed that new claims 24-31 are also directed to allowable subject matter. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if there are any questions regarding the above new claims or if prosecution of this application may be assisted thereby.

Respectfully submitted,  
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Date: January 16, 2004

By:

  
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MAH/kw

# Annotated Sheet Showing Changes

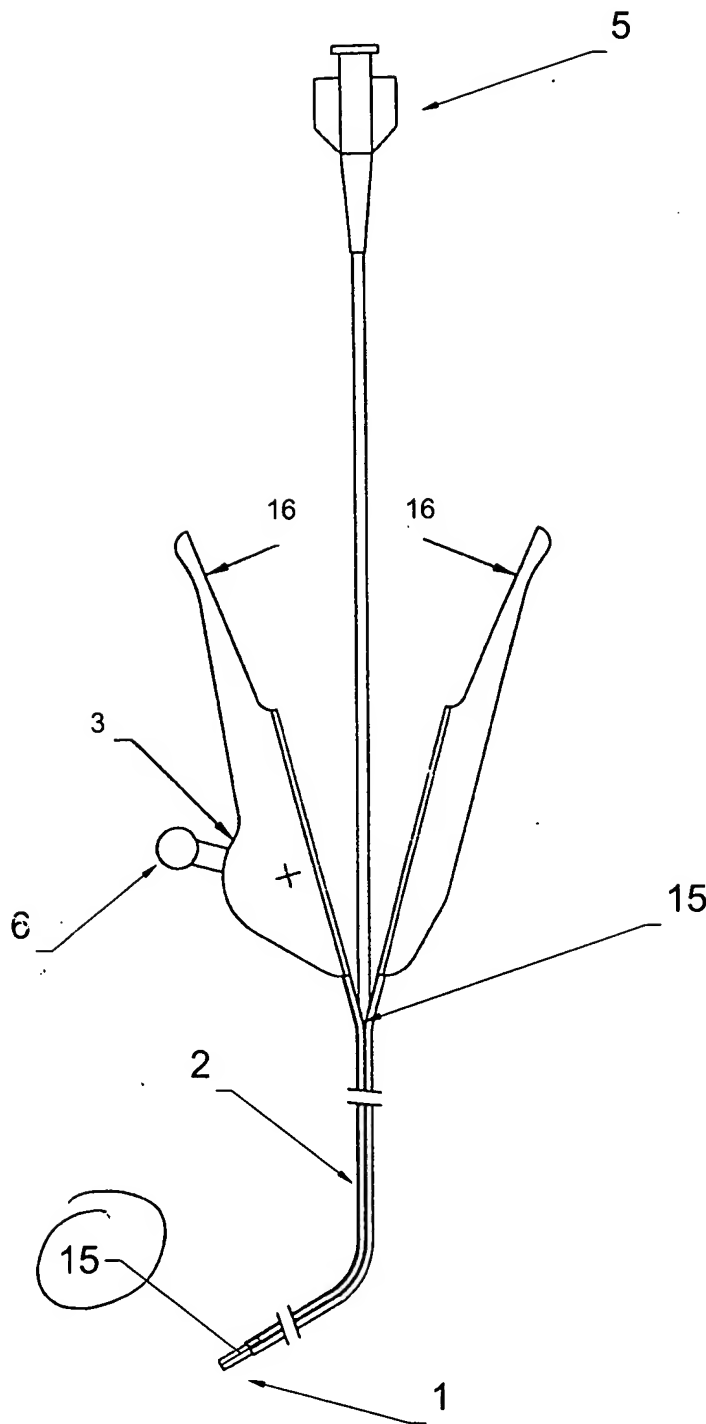


Fig. 5

pre-stress  
line 15 added  
to inner sheath.  
No new matter  
has been added.